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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,425	01/17/2002	Kevin Auton	65446-0082	9516

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EXAMINER

MATHEWS, ALAN A

ART UNIT PAPER NUMBER

2851

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/913,425	Applicant(s) AUTON ET AL.	
	Examiner Alan A. Mathews	Art Unit 2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-30,35-51 and 54 is/are rejected.
- 7) ☒ Claim(s) 3,31-34,52 and 53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4-10, 12-30, 35-51, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Parekh et al. (U. S. Patent No. 6,604,754, which is cited on Applicant's PTO-1449 and which is the U. S. equivalent to WO-A-9823950 cited on Applicant's PTO-1449 and which is cited in the corresponding PCT to the instant application). Parekh et al. discloses in column 3, lines 20-22, column 6, lines 19-24, column 7, lines 13-17, and column 8, lines 21-39, an image detector (device) to capture one or more traits associated with one or more samples (proteins). The two-dimensional array is imaged with a detector to generate a computer-readable output that contains a set of x,y coordinates and a signal value for each detected biomolecule. The sample media are the biomolecules in the biological sample. The computer would have the microprocessor. The separated biomolecules are stably maintained in the two-dimensional array and can be stored or achieved. Selected biomolecules can be retrieved from the array at any time based on automated computer analysis of the data derived from imaging. The Abstract

Art Unit: 2851

states on lines 7-12 that computer-mediated comparison of profiles from multiple samples permits automated identification of subsets of biomolecules that satisfy pre-ordained criteria. Column 12, lines 26-59, further discloses comparative analysis, such as between normal tissue and diseased tissue. Column 9, lines 50-62 states that the output of the image processing program can be used to generate digital profiles suitable for comparative analysis. A digital profile preferably comprises, for each identified feature, a unique arbitrary identification code, the x,y coordinates, the isoelectric point, the molecular weight, and the fluorescence intensity (which are reference traits). With respect to claim 2, figure 3 and column 13, lines 31-44 disclose a robotic excision tool run by the microprocessor.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Butts et al. (U. S. Patent No. 4,684,244, cited on Applicant's PTO-1449). Butts et al. discloses in figures 2 and 3 and column 4, lines 41-46, a detector 68 which is a device for electronically capturing one or more traits (optical density pattern) of patterns 78 on sample plates 76. Element 40 is the microprocessor which analyzes one or more electronically captured traits. Column 6, lines 11-19 and column 7, lines 60-72, disclose comparing an electronically captured trait against one of a reference trait

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2851

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parekh et al as applied to claim 1 above, and further in view of either Anderson (U. S. Patent No. 5,993,627, which is the U. S. equivalent to W0 98/590,092 cited in Applicant's PTO-1449) or Sarrine et al. (U. S. Patent No. 4,954,237). Parekh et al. discloses the invention except for specifically disclosing that the device for capturing one or more traits is a camera. Anderson discloses in figure 12 and column 24, lines 54-67, the use of a camera 147 to capture traits (protein spots) of gels for the well-known purpose of better detection. Sarrine et al. discloses in figure 1 the use of a camera for the well-known purpose of better detection. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide Parekh et al. with a camera to capture an optical trait in view of Anderson or Sarrine et al. for the well known purpose of better detection.

Allowable Subject Matter

6. Claims 3, 31-34, 52, and 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reasons for the indicated allowability is as follows:

The prior art of record does not disclose or suggest a microprocessor commanding the robotic excision tool to irrigate the sample media with fluid in combination with all the other elements recited in the parent of dependent claim 3.

The prior art of record does not disclose or suggest a microprocessor commanding the robotic excision tool to grip and eject an interchangeable tip fluid in combination with all the other elements recited in the parent of dependent claim 31.

The prior art of record does not disclose or suggest the means to grip and eject the interchangeable tip includes a cylindrical inflatable cuff, and ejection spring, and means to control pressure to and from the inflatable cuff from pressure sources fluid in combination with all the other elements recited in the parent of dependent claim 32

The prior art of record does not disclose or suggest the step of gripping the interchangeable coring tool through inflation of a cylindrical inflatable cuff inside the coring tool by liquid or gas pressure fluid in combination with all the other elements recited in the parent of dependent claim 52.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents on Applicant's PTO 1449 are cited for the same reasons Applicant cited them in his INFORMATION DISCLOSURE STATEMENT.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan A. Mathews whose telephone number is (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-2847. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Alan A. Mathews
Primary Examiner
Art Unit 2851

AAM